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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

IND-126

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November 19, 2008

on _____

Signature _____

Typed or printed name _____
Carol Prentice

Application Number

10/683,568

Filed

October 10, 2003

First Named Inventor

Hornung

Art Unit

3633

Examiner

Phi Dieu Tran A

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒

attorney or agent of record.

Registration number 28,637

☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

Signature

Barry R. Lipsitz

Typed or printed name

203-459-0200

Telephone number

Nov. 19, 2008

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒

*Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Robert E. Hornung, et al.

Serial No.: 10/683,568

Filed: October 10, 2003

Attorney Docket No.: IND-126

Examiner: Phi Dieu Tran A

Art Unit: 3633

For: **GRID MUNTIN RETAINING CLIPS FOR MUNTINS**

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
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By:

Carol Prentice

Carol Prentice

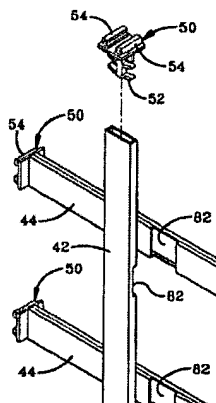
PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicants hereby request review of the above-referenced patent application prior to the filing of an appeal brief. A notice of appeal is being filed concurrently herewith.

The present application contains one independent claim (claim 124) and ten dependent claims (claims 125-134). All of the claims stand rejected under 35 U.S.C. §102(b) as being anticipated by Digman et al US Patent 5,657,590. Claims 125, 127 and 130 were also rejected under 35 U.S.C. §112 as being indefinite. The §112 rejection is not understood, as claims 125, 127 and 130 are claiming a clip. The fact that the clip of claim 125 is mounted in a channel is not believed to render the claim indefinite. Similarly, the fact that the clip of claim 130 is configured to couple to a locating notch formed in the spacing and mounting structure is not believed to render the claim indefinite.

Claim 124 sets forth a generally C-shaped clip with a muntin retainer extending therefrom, as illustrated, e.g., in Figs. 22A and 22B. An annotated portion of Fig. 22A is provided as **EXHIBIT A** hereto. The claimed clip includes upper and lower resilient fingers. The lower resilient finger is connected at only one end thereof to the upper resilient finger and extends generally perpendicularly from the upper resilient finger at said one end. The lower finger turns to become generally parallel with the upper finger. The combination of the upper finger and the generally perpendicular and generally parallel portions of the lower finger forms the C-shaped cross section. At the open end of the C-shaped cross section, an end of the upper finger extends beyond the end of the lower resilient finger. At the closed end of the C-shaped cross section, an end of the upper finger extends beyond the end of the lower finger that is connected to the upper finger. The muntin retainer projects from an upper surface of the upper finger at a substantially 90° angle.

The Examiner contends that Fig. 3 of the Digman reference anticipates Applicant's claimed structure. An annotated version of Digman Fig. 3 is provided as **EXHIBIT B** hereto. Contrary to the Examiner's position, the Digman clip is not generally C-shaped. Moreover, the Examiner states that elements 40 of Digman are equivalent to Applicant's claimed muntin retainer. A review of column 3, lines 11-14 of Digman indicates that elements 40 are barbed pins that fit into mating holes in the window frame members. They are *not* muntin retainers. In Digman, the muntin retainer is the spine 32, which fits into the muntin bar. A clip which is similar to the Digman clip is illustrated in Fig. 4 of U.S. Patent 6,868,596 cited by the examiner in the PTO-892 form sent with the Office Action of October 16, 2008, a portion of which follows:



As can be seen, the portion of the clip that serves as the muntin retainer is the portion with fins, which is inserted into the muntin bar. The barbed pins are used to attach the clip to the window frame as illustrated in Fig. 1 of Digman and explained in Digman column 3, lines 11-14.

The Examiner further contends that element 33, 38 of Digman anticipates Applicant's upper resilient finger, and that element 34 of Digman anticipates Applicant's lower resilient finger. To the contrary, however, element 33 of Digman is an end connector for mounting the clip to a window unit, and element 38 is a portion of the end connector that serves as an end stop platform. Neither of these elements is an "upper resilient finger" as claimed by Applicants. Moreover, element 34 of Digman is a stabilizing end of the spine 32 (see Digman col. 3, lines 1-3). The spine 32, angled fins 36 and stabilizing end 34 act together to form a muntin retainer that is inserted into the muntin bar as noted above. None of these elements is a "lower resilient finger" as claimed by Applicants. And, as noted above, the clip of Digman does not have a generally C-shaped cross section as required by Applicants' claims.

In particular, Applicants' claim 124 specifies "the combination of said upper resilient finger and the generally perpendicular and generally parallel portions of said lower resilient finger forming a generally C-shaped cross section." An example of this structure is clearly shown in Exhibit A hereto. The Digman reference does not disclose anything similar, and clearly does not anticipate Applicants' claimed structure.

Applicant's dependent claims further distinguish over the Digman reference. For example, in claim 126 the end of Applicants' lower resilient finger at the open end of the C-shaped cross section is configured to resiliently couple to a portion of a channel of a spacing and mounting structure. In Digman, the element 34 (which the Examiner states is a "lower resilient finger") cannot possibly couple to a portion of such a channel, since it will be completely covered when inserted into the muntin bar.

Applicants' claim 128 requires the lower resilient finger to be configured to flex upon insertion between glazing legs of a spacing and mounting structure. In Digman, the element 34 is inserted into the muntin bar. This element is never inserted between

glazing legs of a spacing and mounting structure. Even if it were, it does not appear to be designed in a manner that would allow it to flex.

Applicants' claim 130 requires an end of the lower resilient finger at the open end of the C-shaped cross section to be configured to couple to a locating notch formed in the spacing and mounting structure. There is no equivalent structure disclosed in Digman. Element 34 of Digman, which the Examiner contends is the "lower resilient finger", is inserted into the muntin bar and is not available to couple to a locating notch of a spacing and mounting structure. Moreover, Digman does not disclose such a spacing and mounting structure nor such a notch.

Applicants' claim 131 requires the lower resilient finger to be configured to snap-fit between glazing legs of a spacing and mounting structure. There is no such mounting structure disclosed in Digman, and element 34 is not placed between glazing legs as taught by Applicants. Instead, element 34 of Digman is inserted into a muntin bar, where it is completely covered and serves no other purpose than to attach the clip to the muntin bar. Element 34 has nothing to do with attaching the clip to the window frame.

Applicants claim 132 states that the upper resilient finger is configured to snap-fit to a spacing and mounting structure. Digman's elements 33, 38 (which the Examiner contends anticipate Applicants' upper resilient finger) do not snap fit to anything. In Digman, the clip is held to the window frame by barbed pins 40.

In view of the above, withdrawal of the rejections set forth in the Final Office Action and allowance of the present application is respectfully requested.

Respectfully submitted,



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Exhibit A

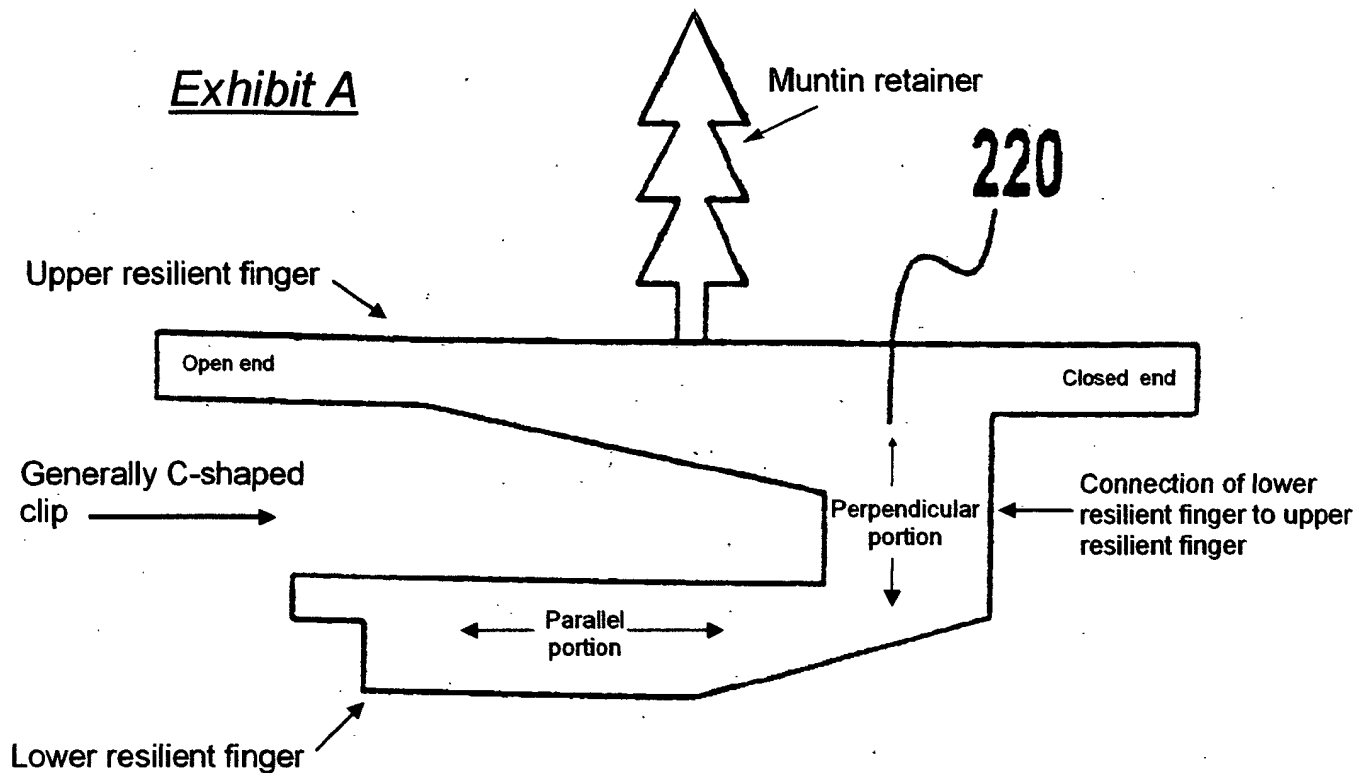


Exhibit B

